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OFFICE OF PETITIONS

In re Patent No. 5,587,789
Issue Date: December 24, 1996
Application No. 08/227,281
Filed: April 13, 1994
Patentee: Lee, et al.

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DECISION ON PETITION

This is a decision on the Request for Reconsideration of a Decision on Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b)), filed August 26, 2003.

The petition under 37 CFR 1.378(b) is GRANTED.

Background:

The above-identified patent issued December 24, 1996. Accordingly, the first maintenance fee could have been paid during the period from December 24, 1999 through June 24, 2000 without surcharge, or with a surcharge of \$65 during the period from June 25, 2000 through December 24, 2000. The patent expired on December 25, 2000.

On June 30, 2003, petitioner LG Electronics (LG) filed a petition to reinstate the expired patent pursuant to 37 CFR 1.378(b). Petitioner set forth the following facts. In early 1997, LG undertook a transfer of the responsibility to pay maintenance fees on its patents from individual law firms to one company - MARKPRO. Through an extensive process in which numerous correspondence was exchanged between the various law firms, LG Headquarters, LG's technical divisions, and MARKPRO, a list of LG's patents was compiled. On March 29, 1997, MARKPRO sent to LG Headquarters an updated final list of approximately 1,500 patents for which MARKPRO would takeover responsibility for maintenance fee payments. LG Headquarters then sent this list to its technical divisions with instructions to check for revisions, additions, or deletions. Any changes to the list were to be returned to LG Headquarters by April 15, 1997.

However, LG did not receive the above patent until April 16, 1997, one day after the final revised list of patents was due back from LG's technical divisions to LG Headquarters. Therefore, petitioner states that the above patent was never reported to MARKPRO, so MARKPRO did not know about the patent and did not pay the maintenance fee.

The petition was dismissed in a decision mailed on July 17, 2003. Petitioner did not satisfactorily explain what transpired on or after April 16, 1997.

Petitioner has filed the instant request for reconsideration, asserting that the failure to timely pay the maintenance fee in the above patent was unavoidable.

Law and Analysis:

37 CFR 1.378(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee must include:

- (1) The required maintenance fee set forth in 37 CFR 1.20(e) through (g) (currently \$890);
- (2) The surcharge set forth in 37 CFR 1.20(i)(1) (currently \$700); and
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The instant petition does not meet requirement (3) above.

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 USC 133. **This is a very stringent standard.** Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that: (1) the error was the cause of the delay at issue; (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and (3) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the due exercise of due care. See MPEP 711.03(c)(III)(C)(2).

On request for reconsideration, petitioner has included an affidavit signed by Mr. Saeng Gyu Jeon, senior manager at LG, Mr. Woon Kyu Chang, manager at LG, and Ms. Kyung Suk Bhang, data entry specialist at LG. According to the affidavit, the above patent was received and recorded by Bhang on April 16, 1997. However, Bhang was of the erroneous understanding that the patent had been included on the list of patents reported to MARKPRO. In addition, the affidavit set forth that Bhang had been employed by LG for over two years, had received one month of on-the-job training, and two to three days of training each year. Lastly, the petition established that there was a reasonable business routine in place concerning the transfer of the responsibility to pay maintenance fees to MARKPRO.

Conclusion:

In view of the above, the petition is granted.

The \$130 fee for a request for reconsideration (See 37 CFR 1.378(e)) has been charged to Deposit Account No. 02-2448, as authorized.

The maintenance fee in this case is accepted and the above identified patent is hereby reinstated as of the mail date of this decision.

The file is being returned for storage to Files Repository.

Telephone inquiries specific to this decision may be directed to Petitions Attorney Cliff Congo at (703) 305-0272.


Beverly Flanagan
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Office of Petitions